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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/894,156	08/15/1997	BERND BRUCHMANN	524-2769-0	8696

22850 7590 03/25/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/25/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/894,156

Applicant(s)
Bruchmann et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-11, and 13-17 is/are rejected.
- 7) ☒ Claim(s) 12 and 18 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 1711

1. The request filed on March 11, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/894,156 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 1-5, 8-11, and 13-15 are rejected on the grounds of *res judicata*. The subject matter of the claims, including the amended language of the mole percents of components b) and c), involves the same issues as has been previously decided by the Board of Appeals. The mole percent limitations were previously set forth within appealed claims 6 and 7, and it is noted that during the appeal, each claim was indicated as standing or falling separately; therefore, the position is taken that this issue was clearly before the Board or Appeals. Furthermore, no new evidence has been presented; the argued tables were present for consideration before the Board of Appeals at the time of the appeal.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

Art Unit: 1711

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 8-11, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohring et al. ('350 or '956) in view of Wagner et al. ('127 or '622) and Hennig et al. ('956).

Mohring et al. disclose the production of biuret containing polyisocyanates having a low unreacted polyisocyanate monomer content and light color, wherein diisocyanates are reacted with an alcohol component, including tertiary alcohols; an amine component; and water. See column 3, lines 10+ and columns 4-7.

5. While Mohring et al. disclose the use of amines, patentees fail to disclose the use of applicants' claimed nitrogen containing stabilizer. However, applicants' claimed stabilizers were known at the time of invention to be useful agents for the production of biurets. See column 6, lines 8+; column 9, lines 9+; and column 11, lines 35+, within Wagner et al. See column 1, lines 53+ and column 2 within Hennig et al. Furthermore, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color. See examples. Additionally, it is noted that Wagner et al. disclose both amines and urea derivatives as being suitable agents for the production of biurets.

6. Therefore, one of ordinary skill in the art would have been motivated to utilize the nitrogen containing biuretizing agents of the secondary references in place of the amine

Art Unit: 1711

component of Mohring et al., because one would have reasonably expected the nitrogen compounds of the primary reference and secondary references to function as equivalents, in view of the teachings within the secondary references. It has been held that it is *prima facie* obvious to substitute an equivalent component for another, where equivalency is known within the art. *In re Ruff*, 118 USPQ 343 (CCPA 1958). Furthermore, it has been held that it is *prima facie* obvious to combine components, known to be useful for the same purpose, to yield a third component to be used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069. Therefore, the position is further taken that it would have been obvious to combine known biuretizing agents, such as tert-butanol and urea, to yield a biuretizing composition suitable for producing a biuret.

7. Furthermore, the position is taken that it would have been obvious to substitute the claimed species, acetamide, for the formamide species set forth within column 9 of Wagner et al. It has been held that when chemical compounds have "very close" structural similarities and similar utilities, a *prima facie* case of obviousness may be made. *In re Grabiak*, (CAFC 1985) 769 F2d 729, 226 USPQ 870.

8. With respect to applicants' arguments concerning the claimed amounts of the stabilizer versus the amounts disclosed within Wagner et al., it is noted that this issue was discussed by the Board of Appeals; the Board Of Appeals agreed with the examiner's rationale that the amounts used within the respective processes are comparable.

9. The examiner has considered applicants' discussion of the data set forth within the tables; however, the position is taken that it has not been established that the showings rise to the level of


Art Unit: 1711

being unexpected. As aforementioned, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color; therefore, one would expect the argued color numbers.

Furthermore, applicants have not established that quantitative increases in properties proportional to increases in the amount of component utilized is indicative of an unexpected result.

10. Claims 12 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

March 23, 2003